UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/588,037	06/05/2000	J. Gregory Stout	40116/05504	8559

83694 7590 03/12/2009

Fay Kaplun & Marcin, LLP/ Motorola
150 Broadway Suite 702
New York, NY 10038

EXAMINER	
KOPPIKAR, VIVEK D	
ART UNIT	**PAPER NUMBER**
3686	

MAIL DATE	DELIVERY MODE
03/12/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte J. GREGORY STOUT

Appeal 2008-5924
Application 09/588,037
Technology Center 3600

Decided:[1] March 12, 2009

Before MURRIEL E. CRAWFORD, DAVID B. WALKER, and JOSEPH A. FISCHETTI, *Administrative Patent Judges.*

WALKER, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal under 35 U.S.C. §§ 6(b) and 134(a) (2002) from the final rejection of claims 30-49. We reverse.

Representative claim 30 reads as follows:

---

[1]The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

30. A method, comprising:

identifying a consumer using a data capture device at a first merchant location where the consumer presents an instrument during a processing of a first transaction at the first merchant, wherein the consumer is identified with a unique identification stored in a data farm device;

presenting an offer to the consumer on an offer display device, the offer based on information from the first transaction;

receiving an indication of acceptance of the offer from the consumer at the first merchant location;

associating the indication of acceptance with the unique identification of the consumer;

identifying the consumer using a further data capture device at a second merchant location where the consumer presents the instrument during the processing of a second transaction; and

retrieving the offer based on the identification of the consumer at the second merchant location, wherein the offer is applied to the second transaction.

The reference set forth below is relied upon as evidence in support of the rejections:

Gardenswartz	US 6,055,573	Apr. 25, 2000

The Examiner rejected claims 30-49 under 35 U.S.C. § 102(e) as anticipated by Gardenswartz. The dispositive issue is whether the Appellant has shown that the Examiner erred in finding that Gardenswartz teaches

"receiving an indication of acceptance of the offer from the consumer at the first merchant location" and "retrieving the offer based on the identification of the consumer at the second merchant location, wherein the offer is applied to the second transaction."

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987).

With respect to claim 30, the Appellant argues that Gardenswartz does not disclose "receiving an indication of acceptance of the offer from the consumer at the first merchant location" and "retrieving the offer based on the identification of the consumer at the second merchant location, wherein the offer is applied to the second transaction" (Br. 6).

The Examiner found that the Appellant based this argument on three subsidiary arguments, specifically that Gardenswartz: (1) teaches that the first retail location and the second retail location are the same, contrary to the limitations of claim 30; (2) does not specify that the consumer must accept the offer during a first transaction at a first merchant location; and (3) does not mention or suggest the step "associating the indication of acceptance with the unique identification of the consumer" (Answer 5).

With respect to the first argument, the Examiner found that Gardenswartz teaches that the first merchant location is separate from the second merchant location (citing Figure 1; col. 5, ll. 36-42 and 61-67; col. 19, ll. 37-48). The Appellant argues that the Examiner mistakenly relies on computers 10 and 12 as first and second merchants, when they are separate from retail stores 2-6, and are described as being home or office computers

connected to the Internet (Reply Br. 3, citing Gardenswartz, col. 5, l. 61 – col. 6, l. 4 and col. 6, ll. 36-52). This argument is not persuasive as Gardenswartz shows multiple distinct retail stores, 2, 4, and 6 (Gardenswartz, Figure 1).

With respect to the second argument, the Examiner found that Gardenswartz teaches that the consumer must accept the offer during a first transaction at a first merchant location (citing col. 19, ll. 37-48). The Appellant argues that because Gardenswartz delivers promotional information to consumers on their home computers in response to past purchases, there is no possibility of acceptance at a first merchant. According to the Appellant, Gardenswartz teaches that the consumer may receive the reward by visiting a specified location (Reply Br. 3, citing Gardenswartz, col. 16, ll. 39-42). Claim 30 requires "receiving an indication of acceptance of the offer from the consumer at the first merchant location," which is the same first merchant location at which the consumer is required to present an instrument during a processing of a first transaction. We agree with the Appellant that Gardenswartz does not teach receiving an indication of acceptance of the offer at a first merchant location where a first transaction takes place.

With respect to the third argument, the Examiner found that Gardenswartz teaches associating the indication of acceptance with the unique identification of the consumer (citing col. 17, ll. 18-28 and col. 19, ll. 42-48). The Appellant argues that Gardenswartz describes offering the consumer different value contracts based on whether the consumer complies with the terms of the contract, which does not indicate acceptance. According to the Appellant, the consumer in Gardenswartz does not

announce his intention to redeem the reward and may even trigger the reward conditions inadvertently (Reply Br. 4, citing Gardenswartz, col. 17, ll. 19-42 and col. 16, ll. 50-63). The Appellant further argues that, at most, Gardenswartz describes providing an indication to the consumer that he is eligible for a reward or that he has satisfied the conditions for a reward, and the consumer must still decide whether or not to accept the reward by fulfilling the conditions and then visiting the specified retail location (Reply Br. 5). We agree with the Appellant. Moreover, based on argument (2) above, the failure of Gardenswartz to teach the required "receiving an indication of acceptance . . ." precludes associating the indication of acceptance with the unique identification of the consumer. The Appellant thus has shown the Examiner erred in rejecting claim 30, and claims 31-36, which depend therefrom.

Claim 37 recites

> an offer display device which receives the one of the offers from the data farm, displays the one of the offers to the consumer, receives an indication of acceptance of the one of the offers from the consumer and forwards the indication of acceptance to the data farm device, wherein the data farm device stores the indication of acceptance in the unique identification record of the consumer.

The Appellant argues that these are substantially the same limitations argued with respect to claim 30 above (Reply Br. 5). For the reasons discussed above with respect to claim 30, the Appellant has shown the Examiner erred in rejecting claim 37, and claims 38-45, which depend therefrom.

Claim 46 recites "sending the offer to an offer display device at the merchant location" and "receiving an indication of acceptance of the offer from the consumer at the merchant location" and "associating the indication of acceptance with the unique consumer identification record." The Appellant argues that claim 46 contains substantially the same limitations as claim 30, and should be allowable on that basis (Reply Br. 6). For the reasons discussed above with respect to claim 30, the Appellant has shown the Examiner erred in rejecting claim 46, and claims 47-49, which depend therefrom.

The decision of the Examiner is reversed.

REVERSED

hh

Fay Kaplun & Marcin, LLP/ Motorola
150 Broadway Suite 702
New York, NY 10038